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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/077,591	02/15/2002	James Larkins	DEKA:299US	1557

7590 02/17/2004

FULBRIGHT & JAWORSKI L.L.P.  
A REGISTERED LIMITED LIABILITY PARTNERSHIP  
SUITE 2400  
600 CONGRESS AVENUE  
AUSTIN, TX 78701

EXAMINER
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FOX, DAVID T

ART UNIT	PAPER NUMBER
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1638

DATE MAILED: 02/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/077,591	Applicant(s) LARKINS, JAMES	
	Examiner David T. Fox	Art Unit 1638	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 November 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,2,5,7-10,12-14 and 21-23 is/are allowed.
- 6) ☒ Claim(s) 3-4,6,11,15-20 and 24-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

Appellants' Brief of 26 November 2003 has been received. The allowability of claims 3-4, 6, 11, 15 and 17-20 as indicated in the Office action of 01 July 2003 is hereby WITHDRAWN in view of the new grounds of rejection below. Finality of the Office action of 01 July 2003 is also WITHDRAWN. The delay in prosecution is regretted.

The art rejection of claim 31 has been WITHDRAWN upon further consideration. It was improper to apply a product-by-process analysis to a process claim. All other rejections of record have been maintained. Applicants' arguments in the Appeal Brief of 26 November 2003 regarding all remaining rejections will be deferred until the new grounds of rejection set forth below have been addressed.

Claims 16 and 27-30 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, as stated in the Office action of 30 January 2003 on page 2.

Claims 16 and 24-31 remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, as stated on pages 2-4 of the Office action of 30 January 2003.

Claims 16 and 24-31 remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter

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which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention, as stated on pages 5-7 of the Office action of 30 January 2003.

Claims 1-31 are free of the prior art, as stated on page 3 of the last Office action for claims 1-30.

Claims 1-2, 5, 7-10, 12-14 and 21-23 remain allowed, as stated on page 3 of the last Office action for claims 1-15 and 17-23.

Claims 3-4, 6, 11, 15-20 and 28-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Dependent claims are included in all rejections.

Claim 3 is indefinite in its recitation of "further defined as an essentially homogeneous population of seed" whose effect on the scope of the claim is unclear. The plain meaning of claim 2, on which claim 3 depends, is a homogeneous population of genetically identical inbred seed. Thus, the "essentially homogeneous" language would appear to be superfluous. However, reading the claims in light of the specification, lines 19-21 of page 5 indicate that inbred seed can form less than 100% of an essentially homogeneous population. Thus the scope of claim 3 is unclear. If claim 3 were amended to read ---An essentially homogeneous population of corn seeds consisting essentially of the inbred corn seed of claim 1---, the claim would have a definite meaning.

Claim 4 is indefinite in its recitation of “further defined as essentially free from hybrid seed” as its effect on the scope of the claim is unclear. Claim 2 from which it depends does not mention hybrid seed, and the plain meaning of that claim is a homogeneous population of inbred seed. Amending the claim to read ---A population of corn seeds consisting essentially of the inbred corn seed of claim 1, and essentially free from hybrid seed--- would obviate this rejection.

Claims 6, 11 and dependents are indefinite in their recitation of “in accordance with” as the degree of identity intended is unclear. Furthermore, “an SSR profile...in Table 5” is unclear, as Table 5 depicts morphological trait characteristics of a single hybrid. In addition, “an isozyme typing profile...in Table 6” is unclear, since Table 6 depicts SSR profiles, while Table 7 depicts isozyme profiles. Finally, “an...profile” is unclear, since each of Table 6 and Table 7 depict profiles from three inbred corn cultivars—the claimed cultivar and two others.

Claims 15, 17, 20 and dependents are indefinite in their recitation of “capable of”, as it is unclear whether or not the corn plant does or does not actually express the physiological and morphological characteristics of the exemplified corn inbred, at any developmental stage or in any environment. Claim 17 is also indefinite in its recitation of “capable of regenerating” as it is unclear whether or not the plants with the desired traits are actually regenerated. Replacement of “is capable of regenerating” and “capable of expressing” with ---regenerates--- and ---expressing---, respectively, would obviate this rejection.

Claim 28 is indefinite in its recitation of "single locus was stably inserted into a corn genome" which is confusing, as a locus is a position on a genome rather than a piece of DNA or a gene. Furthermore, it is unclear whether the locus was inserted into the genome of the corn plant of claim 27, or some other corn plant, given the recitation of "a genome". Replacement of "a" with ---the--- would obviate this aspect of the rejection.

Claim 29 is indefinite in its recitation of "locus is selected... dominant allele and a recessive allele" which is confusing, since a locus is a location on a genome, and is not an allele.

Claim 30 is indefinite in its recitation of "yield enhancement", "improved nutritional quality", and "enhanced yield stability", as "enhanced" and "improved" are relative terms which do not clearly specify the degree of trait expression.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David T. Fox whose telephone number is (571) 272-0795. The examiner can normally be reached on Monday through Friday from 10:30AM to 7:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson, can be reached on (571) 272-0804. The fax phone number for this Group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

February 4, 2004

DAVID T. FOX  
PRIMARY EXAMINER  
GROUP 180-1638

